

REMARKS

Claims 1-28 are all the claims pending in the application.

Applicant respectfully submits that claim 1 is patentable because the personal computer 72 of Howards Koritzinsky cannot possibly correspond to the claimed mobile image data reception device. Although the Examiner states that “a personal computer is capable of being moved, especially in the case of a laptop or notebook device,” nowhere in Howards Koritzinsky is there any mention of the personal computer 72 as being mobile. The Examiner’s arguments appear to be based on a supposed inherent disclosure of a mobile image data reception device by the personal computer 72.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

M.P.E.P. § 2112(IV). Here, the Examiner has failed to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic, i.e., mobility of the personal computer 72, necessarily flows. Rather, the personal computer 72 may

have a large display screen to make it effectively immobile. *See id.* Therefore, claim 1 is patentable.

With further regard to claims 2 and 9, these claims describe transmission of a reception or a completion signal to the medical image data storage means. The Examiner appears to concede that this feature is not explicitly taught by Howards Koritzinsky but contends that transfer of such signals are inevitable, or inherent. The Examiner contends the signal will be inevitably transmitted from the subsystem 12. However, claims 2 and 9 describe transfer to a medical image data storage means, which appears to be the opposite transmission that the Examiner points out. Because the end of a transmission can be signaled by alternate methods than that claimed, the rejection is not supportable.

In addition, claims 18, 19 and 21-26 are patentable because nowhere in Howards Koritzinsky is there any teaching, suggestion or motivation for the storage expiration date as claimed. Although the Examiner states that the short-term, mid-term and long-term storage of Sitka discloses the claimed storage expiration date, Applicant respectfully submits that the Examiner is incorrect. Given that the images are moved between storage devices *based on the last time the images have been requested*, there is no way for determining when the images should expire, *a priori*, in Sitka. In other words, Sitka cannot possibly set an expiration date since any requests for the images in the interim would negate the previously set expiration date. Therefore, the reference cannot possibly teach, suggest or provide motivation for the storage expiration date, as recited in the claims.

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. APPLN. NO.: 09/910,836

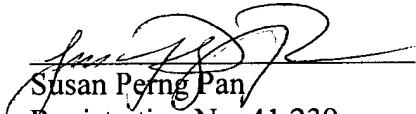
ATTY MATTER NO.: Q65448

The remaining claims are patentable for at least the reasons submitted for their base claims and for the reasons submitted in the Response of July 14, 2005.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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23373
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Date: March 20, 2006